

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



REASONS FOR PRE-APPEAL BRIEF REVIEW

In the Office Action mailed March 17, 2006 (hereinafter, the “Office Action”), Claims 1-13, 15, and 17-22 were finally rejected. Claims 1 and 2 were rejected under 102(b) as allegedly anticipated by Christensen (US 3,049,843), Claims 1-3 were rejected under 102(b) as allegedly anticipated by Scott (US 4,920,947), Claims 1-2, 4-7, 9-10, 17, and 20 were rejected under 102(b) as allegedly anticipated by Pratt (US 3,028,710), Claims 8, 12-13, 18-19, and 21 were rejected under 103(a) as allegedly unpatentable over Pratt, and Claims 11, 15, and 22 were rejected under 103(a) as being allegedly unpatentable over Pratt in view of either Oliver (US 4,916,869) or Skeem (US 6,817,936). In the following discussion Applicant has focused on specific aspects of the claimed invention which are clearly not taught or suggested by the cited references. This does not preclude Applicant from arguing additional deficiencies in the cited references during any later Appeal proceedings or prosecution.

The Claimed Invention

In the present application, the Applicant is claiming a reciprocating frame saw blade for cutting a workpiece which includes:

- a) a blade member having a concave cutting edge; and
- b) a plurality of superabrasive tool segments brazed along the cutting edge of the blade member.

Claim 1 recites that what is being claimed is a reciprocating frame saw blade. Though this recitation is in the preamble, MPEP § 2111.02 states that “[a]ny terminology in the preamble that

limits the structure of the claimed invention must be treated as a claim limitation.” The terminology “reciprocating frame saw” limits the structure of the blade and therefore must be treated as a claim limitation. The Examiner has argued in the Office Action that the term “reciprocating frame saw blade” is without structure, and therefore does not provide a limitation to the claims. The specification, however, defines a frame saw as an essentially straight blade supported at both ends that cuts in both directions (page 8, lines 30-31). It is the Applicant’s position that this definition is well known in the art, and that the mere recitation of the term “reciprocating frame saw” would provide one of ordinary skill in the art with such structural limitations. Additionally, the frame saw blade is further limited by the claims in that it has a concave cutting edge to more effectively generate downward force during cutting, as shown in FIG. 15 (page 17, lines 24-27).

Rejection under 35 U.S.C. § 102(b) over Christensen, Scott, and Pratt

Applicant respectfully submits that neither Christensen, Scott, nor Pratt teach a reciprocating frame saw blade having a concave cutting edge. Christensen and Pratt each teach circular saw blades, as shown in FIG. 1 of each reference, and thus do not teach or suggest that the cutting edge may be concave. The Examiner argues that the slots cut into the blades of these references, are examples of a concave cutting edge. The Applicant strongly disagrees with this assertion. One of ordinary skill in the art would understand that a cutting edge of a saw blade is the edge that cuts the workpiece. Slots cut for various purposes in the blade would not be covered under the definition of a cutting edge, particularly when they are not intended to contact or cut the workpiece.

Christensen and Pratt also do not teach or suggest a reciprocating frame saw blade. The present specification clearly distinguishes between a circular saw blade and a reciprocating frame

saw blade by indicating that a circular saw blade can only cut through less than $\frac{1}{2}$ of its diameter (page 8, line 15-23). The Examiner has indicated that a circular saw blade can be used to cut in a reciprocating motion. It is the Applicant's position that the Examiner is extending the teachings of these references beyond what was intended. There is no teaching or suggestion in either reference that the circular saw blade be mounted in a frame and used in a reciprocating motion. Christensen indicates, for example, that the wheel has a central arbor hole for mounting the wheel on a rotating mechanism (col. 2, lines 36-40). Pratt similarly indicates that the wheel have a central aperture for mounting the disk on a rotating shaft (col. 2, lines 4-8). Furthermore, neither of these wheels can be considered to be frame saw blades as defined by the present specification, because they do not include "an essentially straight blade supported at both ends."

Christensen and Pratt teach circular cutting wheels having a convex cutting edge. These references additionally do not teach or suggest a reciprocating motion for cutting, nor do they teach an essentially straight blade supported at both ends. Therefore, both references clearly fail to teach one or more essential elements of the claimed invention. Applicant respectfully submits that neither Christensen nor Pratt anticipates the claimed invention for at least the reasons outlined above.

Scott teaches a chainsaw for cutting aggregate material, including a series of links having a cutting block bonded thereto, with the links riding on the guide bar (column 4, lines 49-55; column 5, lines 11-15; FIGs. 1 and 2). The guide bar (26) has substantially straight bottom and top guide edges (column 5, lines 1-2). The bottom edges (50) of the side links that support the cutting blocks ride along a bearing strip (60) bonded along the straight top portion of the guide bar (26) (column 5, lines 12-16; FIGs. 2 and 3). Note that FIG. 3 shows the close interaction of

the link (42) supporting the cutting block (44) and the straight edge of the bearing strip (60).

Scott does not teach or suggest a reciprocating blade member, nor does it teach or suggest a blade member having a concave cutting edge. Scott teaches a chainsaw blade that cuts in a single direction, as indicated by the arrows in FIG. 1. Though Scott does teach that the chainsaw blade can cut in either direction by simply changing the direction of the cutting chain (column 4, lines 29-34), this is not a reciprocating cutting action. Additionally, the chain blade of Scott is not a frame saw blade as defined in the present specification, as it is not a blade member supported at both ends. Additionally, because the bottom edges of the side links that support the cutting blocks ride along the bearing strip which is substantially straight, Scott does not teach a blade member that is concave. The Examiner has argued in the Office Action that the chain blade of Scott may be removed from the chainsaw and assume a concave configuration as a result of flexibility, and may be used on a reciprocating frame saw. It is the Applicant's position that this configuration is not taught nor suggested by Scott, and is the product of hindsight analysis to contort Scott to arrive at the limitations of the present claims. Accordingly, Scott does not teach or suggest a reciprocating motion for cutting, nor does it teach an essentially straight blade supported at both ends. Therefore, this reference clearly fails to teach one or more essential elements of the claimed invention. Applicant respectfully submits that Scott clearly does not anticipate the claimed invention for at least the reasons outlined above.

Accordingly, Applicant respectfully requests that the rejections be withdrawn and the claims be passed to issue.

CONCLUSION

In view of the foregoing, Applicant believes that the present rejections are unsustainable and should be withdrawn. Therefore, Applicant respectfully requests that the prosecution be reopened and/or the claims be allowed. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone Mr. Erik Ericksen, or in his absence, the undersigned attorney, at (801) 566-6633, to address such issues as expeditiously as possible.

Dated this 12th day of June, 2006.

Respectfully submitted,

THORPE, NORTH & WESTERN, LLP



David W. Osborne
Reg. No. 44,989
8180 South 700 East, Suite 200
Sandy, UT 84070
Telephone: (801) 566-6633
Facsimile: (801) 566-0750